



PATENT  
Customer No. 22,852  
Attorney Docket No. 5725.0595-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: )  
)  
Carlos O. PINZON et al. ) Group Art Unit: 1615  
)  
Application No.: 09/733,900 ) Examiner: VENKAT, Jyothsna A.  
)  
Filed: December 12, 2000 ) Confirmation No.: 5474  
)  
For: COSMETIC COMPOSITIONS )  
CONTAINING HETEROPOLYMERS )  
AND OIL-SOLUBLE CATIONIC )  
SURFACTANTS AND METHODS )  
OF USING SAME )  
)

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply Brief to the Board of Patent Appeals and Interference in response to the Examiner's Answer dated April 10, 2006 ("Answer").

**I. Status of the Rejection**

In response to the Supplemental Appeal Brief filed January 17, 2006 ("Appeal Brief"), claims 321-322, 325, 330, 334-335, 337-338, and 348-354 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,783,657 ("Pavlin") in combination with U.S. Patent No. 6,423,324 ("Murphy") and U.S. Patent No. 5,830,483

("Seidel"). Additionally, claims 355-368 remain objected to as being dependent upon a rejected base claim, but the Examiner has indicated that they would be allowable if rewritten in independent form.

## **II. Response to Examiner's Arguments in the Answer**

As noted above, the Examiner maintains the obviousness rejection over Pavlin in combination with Murphy and Seidel. Appellants maintain their position that a *prima facie* case of obviousness has not been established for reasons of record and for the additional reasons set forth below, specifically because there would have been no motivation for one of ordinary skill in the art to combine the teachings of the references.

In the Answer, the Examiner asserts that Pavlin teaches that the polyamide may be combined with colorants and other ingredients to form lipsticks. See Answer at 4. The Examiner also asserts that Pavlin "suggests the addition of emulsifiers also known as surfactants that can be combined with the polymer claimed." *Id.* The Examiner concludes that Pavlin clearly suggests the combination of polymer and emulsifier. See *id.*

While Pavlin discloses that personal care products containing the polymer may also contain emulsifiers, among other categories of ingredients, see col. 17, ln. 27, the generic disclosure of emulsifiers as components that may be incorporated is not a teaching or suggestion of combining oil-soluble surfactants with the disclosed polymer. While emulsifiers are a category of surfactants, that connection alone would not suggest to one of ordinary skill in the art to incorporate oil-soluble cationic surfactants, and Pavlin does not disclose the polymer in combination with oil-soluble cationic surfactants.

The Examiner has admitted that Pavlin does not disclose cationic surfactants, let alone oil-soluble ones, see Answer at 4, and while literal disclosure of that element is not necessary to establish a *prima facie* case of obviousness, some teaching or suggestion of the combination is necessary. As detailed in Appellants' Appeal Brief, such motivation or suggestion is not present in Pavlin.

Contrary to the Examiner's assertions, the motivation or suggestion is not present in Murphy either. The Examiner continues to assert that Murphy provides the necessary motivation because it teaches polyamide resins with surfactants. See Answer at 5. The Examiner neglects to address that Murphy does not teach oil-soluble cationic surfactants in particular, and instead focuses on Murphy's teaching of surfactants as preferable ingredients, see Answer at 5, albeit optional, see col. 8, ln. 66 to col. 9, ln. 2. By glossing over the non-preferred nature of the cationic surfactants as compared to non-ionic surfactants, see *id.* at col. 9, lns. 8-10, and ignoring the lack of a specific disclosure of oil-soluble cationic surfactants, the Examiner fails to appreciate that one of ordinary skill in the art reading Murphy would not be motivated to add a cationic surfactant, let alone an oil-soluble one, to the composition of Pavlin.

The Examiner also asserts that Murphy teaches advantages of combining a polyamide resin and blend of surfactants to include transfer resistance, and such an advantage would motivate one of ordinary skill in the art to combine a cationic surfactant with the polyamide containing composition of Pavlin. See Answer at 5. The Examiner incorrectly attributes these advantages to the surfactants. Murphy is directed to a composition containing a polyamide resin, solvent, and gelling agent, which has the advantageous properties described by the Examiner. See *e.g.*, Abstract, col. 4, lns. 13-

15. The surfactant is merely an optional ingredient and not aligned with the advantageous properties as the Examiner implies. Thus, the Examiner's only articulated basis for motivation is not accurate.

Similarly, the Examiner seems to imply that the advantageous properties of the compositions of Seidel would motivate one of ordinary skill in the art to combine a particular oil-soluble cationic surfactant disclosed therein with the composition of Pavlin. See Answer at 6. The Examiner neglects to address the points raised by Appellants in their Appeal Brief, wherein they explained that Seidel attributes these properties to the inventive oil-in-water emulsion disclosed therein, see col. 4, lns. 45-52, and not specifically to the presence of an oil-soluble cationic surfactant. Further, there is nothing in any of the references of record to suggest that these properties relied on by the Examiner would be retained in a composition that was not an emulsion, such as the compositions of Pavlin and Murphy.

Finally, the Examiner's assertion that there is a suggestion to combine the elements discussed above because all the references relate to the cosmetic art, see Answer at 7, is not sufficient evidence of motivation either. As Appellants explained in their Appeal Brief and above, there is no specific suggestion of the desirability of the combination here. The Examiner has merely found references that may separately teach components of the claimed invention but that fail to motivate one to use all of the claimed components together. The Examiner improperly uses the present invention as a "blue print" for piecing together elements from the three references. It is illogical to suggest that one of skill in the art would pick a particular oil-soluble cationic surfactant from Seidel for use in the compositions of Pavlin based on the teaching of an entirely

separate reference, Murphy, which describes those surfactants as optional ingredients in the disclosed compositions. This is particularly true in view of the specific disclosures of each reference as detailed in Appellants' Appeal Brief. Accordingly, these three references could not have provided any motivation for one of ordinary skill in the art to reach the presently claimed invention, and Appellants submit that the rejection is improper and should be reversed.

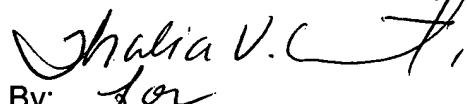
### III. Conclusion

For the reasons set forth above and in Appellants' Appeal Brief, Appellants maintain that a *prima facie* case of obviousness has not been established based on the cited references. The Examiner has failed to demonstrate that one of ordinary skill in the art would be motivated to make the combination proposed. Thus, Appellants respectfully request reversal of the rejection of claims 321-322, 325, 330, 334-335, 337-338, and 348-354 under 35 U.S.C. § 103(a).

If there are any fees due that are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, P.L.P.

By:  , Reg. No. 39,064  
Michelle E. O'Brien  
Reg. No. 46,203

Dated: June 12, 2006